



**UNITED STATES DEPARTMENT OF COMMERCE  
Patent and Trademark Office**

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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.
08/871,601	06/09/97	WOLFINBARGER	L 152-133P-SHK

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EXAMINER

JACKSON, S

ART UNIT

PAPER NUMBER

3738

DATE MAILED:

10/27/98

**Please find below and/or attached an Office communication concerning this application or proceeding.**

**Commissioner of Patents and Trademarks**

# Office Action Summary

Application No.  
**08/871,601**

Applicant(s)  
**LLOYD WOLFENBARGER JR.**

Examiner  
**Suzette Jackson**

Group Art Unit  
**3738**



☒ Responsive to communication(s) filed on Jun 9, 1997

☐ This action is **FINAL**.

☐ Since this application is in condition for allowance except for formal matters, **prosecution as to the merits is closed** in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11; 453 O.G. 213.

A shortened statutory period for response to this action is set to expire 3 month(s), or thirty days, whichever is longer, from the mailing date of this communication. Failure to respond within the period for response will cause the application to become abandoned. (35 U.S.C. § 133). Extensions of time may be obtained under the provisions of 37 CFR 1.136(a).

## Disposition of Claims

☒ Claim(s) 1-84 is/are pending in the application.

Of the above, claim(s) 65, 66, and 70-84 is/are withdrawn from consideration.

☒ Claim(s) 1-16, 20-22, 27, 28, 30, 31, 40-49, 51-60, and 67-69 is/are allowed.

☒ Claim(s) 17-19, 23-26, 29, 32-39, 50, and 61-64 is/are rejected.

☐ Claim(s) \_\_\_\_\_ is/are objected to.

☐ Claims \_\_\_\_\_ are subject to restriction or election requirement.

## Application Papers

☒ See the attached Notice of Draftsperson's Patent Drawing Review, PTO-948.

☒ The drawing(s) filed on Jun 9, 1997 is/are objected to by the Examiner.

☐ The proposed drawing correction, filed on \_\_\_\_\_ is ☐ approved ☐ disapproved.

☒ The specification is objected to by the Examiner.

☒ The oath or declaration is objected to by the Examiner.

## Priority under 35 U.S.C. § 119

☐ Acknowledgement is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d).

☐ All ☐ Some\* ☐ None of the CERTIFIED copies of the priority documents have been  
☐ received.

☐ received in Application No. (Series Code/Serial Number) \_\_\_\_\_.

☐ received in this national stage application from the International Bureau (PCT Rule 17.2(a)).

\*Certified copies not received: \_\_\_\_\_.

☐ Acknowledgement is made of a claim for domestic priority under 35 U.S.C. § 119(e).

## Attachment(s)

☒ Notice of References Cited, PTO-892

☐ Information Disclosure Statement(s), PTO-1449, Paper No(s). \_\_\_\_\_

☐ Interview Summary, PTO-413

☒ Notice of Draftsperson's Patent Drawing Review, PTO-948

☐ Notice of Informal Patent Application, PTO-152

--- SEE OFFICE ACTION ON THE FOLLOWING PAGES ---

## **DETAILED ACTION**

### ***Oath/Declaration***

1. The oath or declaration is defective. A new oath or declaration in compliance with 37 CFR 1.67(a) identifying this application by application number and filing date is required. See MPEP §§ 602.01 and 602.02. The oath or declaration is defective because: It does not identify the citizenship of each inventor.
2. It does not identify the post office address of each inventor. A post office address is an address at which an inventor customarily receives his or her mail and may be either a home or business address. The post office address should include the ZIP Code designation.

### ***Drawings***

3. The drawings are objected to as failing to comply with 37 CFR 1.84(p)(4) because reference character "18" has been used to designate both "second disk" on page 6 line 6 and "first disk" on page 6, line 8. This error has been noted through out the specification. Correction is

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required.

4. The drawings are objected to as failing to comply with 37 CFR 1.84(p)(4) because reference character "14" has been used to designate both "first disk" on page 6, line 4 and "second disk" page 6, line 11. Correction is required.

5. The drawings are objected to as failing to comply with 37 CFR 1.84(p)(4) because reference character "13" has been used to designate both "iliac crest wedge" page 6, line 2 and "graft" page 6, line 8. Correction is required.

### *Content of Specification*

- (a) Detailed Description of the Invention: A description of the preferred embodiment(s) of the invention as required in 37 CFR 1.71. The description should be as short and specific as is necessary to describe the invention adequately and accurately. This item may also be titled

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"Best Mode for Carrying Out the Invention." Where elements or groups of elements, compounds, and processes, which are conventional and generally widely known in the field of the invention described and their exact nature or type is not necessary for an understanding and use of the invention by a person skilled in the art, they should not be described in detail. However, where particularly complicated subject matter is involved or where the elements, compounds, or processes may not be commonly or widely known in the field, the specification should refer to another patent or readily available publication which adequately describes the subject matter.

6. The disclosure is objected to because of the following informalities: On page 23 the specification is written in claim formation on lines 3-20. Appropriate correction is required.

***Claim Rejections - 35 USC § 112***

7. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

8. Claims 17-19, 23-26, 29, 32-39, 50, and 61-64 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the

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subject matter which applicant regards as the invention.

9.. The term "X" in claims 25, 26, and 32-39 is a relative term which renders the claim indefinite. The term "X" is not defined by the claim, the specification does not provide a standard for ascertaining the requisite degree, and one of ordinary skill in the art would not be reasonably apprised of the scope of the invention. It is unclear what applicant describes as "X" because "X" is an unknown variable and can describe many things.

✓ 10. Claim 17 recites the limitation "first incubating" in line 1. There is insufficient antecedent basis for this limitation in the claim.

✓ 11. Claim 18 recites the limitation "second incubating" in 6. There is insufficient antecedent basis for this limitation in the claim.

✓ 12. Claim 19 recites the limitation "step of second incubating" in line 2. There is insufficient antecedent basis for this limitation in the claim.

+ 13. Claim 29 recites the limitation "said alcohol" in line 1. There is insufficient antecedent basis for this limitation in the claim.

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14. Claim 50 does not provide for the range in line 2 . There is insufficient antecedent basis for this limitation in the claim.

15. Claims 24-26 contains the trademark/trade name Allowash<sup>TM</sup>. Where a trademark or trade name is used in a claim as a limitation to identify or describe a particular material or product, the claim does not comply with the requirements of 35 U.S.C. 112, second paragraph. See *Ex parte Simpson*, 218 USPQ 1020 (Bd. App. 1982). The claim scope is uncertain since the trademark or trade name cannot be used properly to identify any particular material or product. A trademark or trade name is used to identify a source of goods, and not the goods themselves. Thus, a trademark or trade name does not identify or describe the goods associated with the trademark or trade name. In the present case, the trademark/trade name is used to identify/describe and, accordingly, the identification/description is indefinite.

***Allowable Subject Matter***

16. Claims 17-19, 23-26, 29, 32-39, 50, and 61-64 would be allowable if rewritten to overcome the rejection(s) under 35 U.S.C. 112, 2<sup>nd</sup> paragraph, set forth in this Office action and to include all of the limitations of the base claim and any intervening claims.

17. Claims 1-16, 20-22, 27, 28, 30, 31, 40-49, 51-60, and 67-69 are allowed.

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***Conclusion***

18. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure. Morse et al. 5,333,626; Morse et al. 5,513,662; Fages et al. 5,725,579; Stone 5,782,915; Knaepler et al 5,591,398; Wolfinbarger, Jr. 5,797,871; Wolfinbarger, Jr. 5,820,581; all show other closely related bone grafts and cleaning techniques.

19. Any inquiry concerning this communication or earlier communication regarding this application should be directed to examiner Suzette Jackson at (703) 308-6516. If you are unable to reach me, please contact my supervisor, Mickey Yu, at (703) 308-2672. In a case requiring immediate assistance, please call (703) 308-0858 to reach the main operator for Sector 3700.

  
SJJ

21 October 1998

  
David H. Willse  
Primary Examiner